UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,889	08/20/2003	Michael P. Coppert	IGT1P319/AC046	8185

22434 7590 04/06/2007		EXAMINER	
BEYER WEAVER LLP		FRANCIS, MARK P	
P.O. BOX 70250			
OAKLAND, CA 94612-0250	ART UNIT	PAPER NUMBER	
	2193		

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Office Action Summary	Application No.	Applicant(s)
		10/645,889	COPPERT, MICHAEL P.
		Examiner	Art Unit	
		Mark P. Francis	2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>20 August 2003</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-48</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-48</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>20 August 2003</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date <u>02/14/05</u>.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to the application filed on August 20, 2003.

2.   Claims 1-48 have been examined.

Oath/Declaration

3.   The Office acknowledges receipt of a properly signed oath/declaration filed
August 20, 2003.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

5.   Claims 13-18, 34-37, and 39-48 are rejected under 35 U.S.C. 101 because the
claimed invention is directed to non-statutory subject matter.

Regarding claim 13,

        In this instance, the language of the claim raises a question as to whether the
claim is directed merely to an abstract idea that is not tied to an environment or machine
which would result in a practical application that would produce a useful, concrete, and
tangible result to form the basis of statutory subject matter under 35 USC 101.

According to the 101 Interim Guidelines, The tangible requirement does not necessarily
mean that a claim must either be tied to a particular machine or apparatus or must
operate to change articles or materials to a different state or thing. However, the
tangible requirement does require that the claim must recite more than a § 101 judicial

exception, in that the process claim must set forth a practical application of that § 101

judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ

at 676-77 (invention ineligible because had "no substantial practical application."). "[An

application of a law of nature or mathematical formula to a ... process may well be

deserving of patent protection." Diehr, 450 U.S. at 187, 209 USPQ at 8 (emphasis

added); see also 21 Corning, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 ("It is for the

discovery or invention of some practical method or means of producing a beneficial

result or effect, that a patent is granted . . ."). In other words, the opposite meaning of

"tangible" is "abstract."

Regarding claim 34,

        Applicant defines a computer-readable media containing a program to use a

probe.

        Applicant fails to show or define anywhere inside the body that the claim

requires the use of hardware. Applicant merely defines software to access a first value

for a first metric, software to generate a message by the probe, and software to send

the message. Thus, the claim as a whole can be implemented using software means

only and does not result in a tangible practical application under 35 U.S.C. 101.

        Applicant needs to add the word storage after the words computer-readable in

the pre-amble to correct this problem.

Regarding claim 39,

Applicant defines a computer-readable media containing a program to use a probe.

Applicant fails to show or define anywhere inside the body that the claim requires the use of hardware. Applicant merely defines software to access a first value for a first metric, software to generate a message by the probe, and software to send the message. Thus, the claim as a whole can be implemented using software means only and does not result in a tangible practical application under 35 U.S.C. 101.

Applicant needs to add the word storage after the words computer-readable in the pre-amble to correct this problem.

The rejection of the base claims are incorporated into their dependent claims.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

7.   A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8.   Claims 1-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Luzzi. (U.S. Pat 6,321,263)

Independent claims

With respect to claims 1 and 19, Luzzi discloses a method for using a probe, (Col 4:14-

20, "...or probe installed at the server...")comprising: accessing a first value for a first

metric by the probe; (Col 4:35-45, "...program metrics...")

generating a message by the probe, the message including the first value for the first

metric; (Col 5:25-38, "...computer probe is configured...to send service requests...")

and sending the message to a monitoring apparatus by the probe. (Col 11:28-40, "...to

generate an alert signal...")

With respect to claims 8,24, and 39, Luzzi discloses a method for using a monitoring

apparatus, comprising: receiving a message; (Col 9:59-67, "...by requesting the

services...")

determining a first value for a first metric from the message; (Col 11:20-35, "...have

exceeded such pre-defined performance criteria...")

determining if the first value for the first metric is acceptable; (Col 12:28-40, "...signaling

the violation of pre-defined performance criteria...")

and if the first value for the first metric is not acceptable, displaying an alert that the first

value for the first metric is not acceptable. (Col 11:28-40, "...to generate an alert

signal...")

With respect to claim 13, Luzzi discloses a system for monitoring software, comprising:

a central computer;(Col 12:5-15, "...a remote central repository...")

a monitoring apparatus installed in the central computer;(Col 15:15-25, "...a monitored application program...")

a first computer;(Col 12:10-15, "...client computer) a first probe installed in the first computer; (Col 12:10-15, "...the AMA probe...")

and a network connecting the central computer and the first computer. (Col 12:10-16, "...and remote on the network...")

With respect to claim 34, Luzzi discloses a Computer-readable media containing a program to use a probe, (Col 15:5-20, "...AMA probe...")the program comprising:

software to access a first value for a first metric by the probe; (Col 11:20-35, "...have exceeded such pre-defined performance criteria...")

software to generate a message by the probe, the message including the first value for the first metric; (Col 12:28-40, "...signaling the violation of pre-defined performance criteria...")

and software to send the message to a monitoring apparatus by the probe. (Col 11:28-40, "...to generate an alert signal...")

Dependent claims

With respect to claim 2, the rejection of claim 1 is incorporated and further, Luzzi discloses further comprising a second sensor to capture a second value for a second metric on the computer. (Col 11:15-35, "...The pre-defined performance criteria may

include such metrics as ...")

With respect to claim 3, the rejection of claim 2 is incorporated and further, Luzzi discloses that the message generator is operative to send a second message to the central site, the second message including the second value. (Col 11:28-35, "...to generate an alert signal...")

With respect to claim 4, the rejection of claim 2 is incorporated and further, Luzzi discloses that the message generator is operative to include the second value in the first message. (Col 11:28-35, "...to generate an alert signal...")

With respect to claim 5, the rejection of claim 1 is incorporated and further, Luzzi discloses a timer, the first sensor operative to capture the first value for the first metric when the timer ends and to reset the timer. (Col 10:35-50, "...the request will timeout...")

With respect to claims 6 and 15, the rejection of claims 1 and 13 are incorporated respectively and further, Luzzi discloses that the first computer includes a software package; (Col 10:5-15, "...by monitoring an application program...")and the first probe monitors the software package. (Col 15:5-20, "...AMA probe software...to a monitored application program...")

With respect to claims 7 and 16, the rejection of claims 1 and 13 are incorporated

respectively and further, Luzzi discloses that the first computer includes a database;

(Col 12:10-20, "...central repository...")and the first probe monitors the database. (Col

12:16-27, "...an multiple monitoring implementation,...")

With respect to claims 9 and 28, the rejection of claims 1 and 13 are incorporated

respectively and further, Luzzi discloses that determining if the first value for the first

metric is acceptable includes determining if the first value for the first metric is within a

range of acceptable values. (Col 11:14-30, "...pre-defined performance criteria may

include such metrics as maximum....")

With respect to claim 10, the rejection of claim 9 is incorporated and further, Luzzi

discloses that the tester includes: a plurality of filters, each filter determining a range of

acceptable values for a metric; (Col 11:14-34, "...the pre-defined performance

criteria...")

and a selector to select the first filter from the plurality of filters based on the first metric

in the first message. (Col 11:14-30, "...pre-defined performance criteria may include

such metrics as maximum....")

With respect to claim 11, the rejection of claim 10 is incorporated and further, Luzzi

discloses that: the plurality of filters includes at least one filter defining a range of

acceptable values for the first metric associated with a site; (Col 11:14-30, "...pre-defined performance criteria may include such metrics as maximum....")

and a selector to select the first filter from the plurality of filters based on a first site in the first message. (Col 11:14-30, "...pre-defined performance criteria may include such metrics as maximum....")

With respect to claim 12, the rejection of claim 8 is incorporated and further, Luzzi discloses comprising a log, the log including an entry corresponding to the first message. (Col 12: 28-35, "...signaling the violation...")

With respect to claim 14, the rejection of claim 13 is incorporated and further, Luzzi discloses the system further comprises: a second computer; (Col 12:1-15, "...on the server computer...")

and a second probe installed in the second computer; (Col 12:1-15, "...including the AMA probe...")

and the network connects the central computer and the second computer. (Col 12:1-15, "...and remote on the network...")

With respect to claim 17, the rejection of claim 13 is incorporated and further, Luzzi discloses that: the monitoring apparatus includes: a message receiver to receive a first message from a first site, (Col 12:28-40, "...signaling the violation of pre-defined performance criteria...")

the first message including a first value for a first metric; (Col 12:28-40, "...signaling the violation of pre-defined performance criteria...")

a tester to determine if the first value is acceptable; (Col 11:15-35, "...A determination...")

and an alerter to alert someone if the first value is not acceptable; (Col 11:15-35, "...to generate an alert signal...")

and the probe includes: a first sensor to capture a first value for a first metric; (Col 12:28-40, "...signaling the violation of pre-defined performance criteria...")

and a message generator operative to send a first message to a central site, the message including the first value. (Col 12:60-67, "...an application availability-based alert signal...")

With respect to claim 18, the rejection of claim 13 is incorporated and further, Luzzi discloses that the first computer includes an e-mail server to generate a message from the first probe to the monitoring apparatus. (Col 11:45-55, "...the network address of the target server...")

With respect to claims 20,30, 35 and 45 the rejection of claims 19,29,34 and 44 are incorporated respectively and further, Luzzi discloses that sending the message includes: delivering the message to an e-mail server by the probe;(Col 18:15-25, "...the session established between...")
delivering the message to the monitoring apparatus by the e-mail server. (Col 12:28-43, "...an alert signal will be generated by the AMA probe...")

With respect to claims 21,31,36, and 46 the rejection of claims 19,29,34, and 44 are incorporated respectively and further, Luzzi discloses that accessing the first value includes accessing a software package by the probe. (Col 10:5-15, "...by monitoring an application program...")

With respect to claims 22,32,37, and 47 the rejection of claims 19,29,34, and 44 are

incorporated respectively and further, Luzzi discloses that accessing the first value

includes accessing a database by the probe. (Col 18:15-25, "...for accessing data

stored in the repository...")

With respect to claims 23,33,38, and 48 the rejection of claims 19,29,34, and 44 are

incorporated respectively and further, Luzzi discloses that generating a message further

includes generating the message by the probe, the message including the first value for

the first metric and an identifier for a site of the probe. (Col 11:28-40, "...to generate an

alert signal...")

With respect to claim 25, the rejection of claim 24 is incorporated respectively and

further, Luzzi discloses comprising, if the first value for the first metric is acceptable,

logging the first value for the first metric. (Col 4:35-45, "...program metrics...")

With respect to claims 26 and 41, the rejection of claims 24 and 39 are incorporated

respectively and further, Luzzi discloses that determining a first value includes

determining the first value for the first metric for a first site from the message; (Col

12:28-40, "...signaling the violation of pre-defined performance criteria...") **and**

determining if the first value for the first metric is acceptable includes

determining if the first value for the first metric for the first site is acceptable. (Col

11:28-40, "...A determination that one of these pre-defined performance

criteria...")

With respect to claims 27 and 42, the rejection of claims 24 and 39 are incorporated respectively and further, Luzzi discloses that determining if the first value for the first metric is acceptable includes comparing the first value for the first metric with at least one acceptable value. (Col 11:14-30, "...pre-defined performance criteria may include such metrics as maximum....")

With respect to claims 28 and 43, the rejection of claims 24 and 39 are incorporated respectively and further, Luzzi discloses that the software to determine if the first value for the first metric is acceptable includes software to determine if the first value for the first metric is within a range of acceptable values. (Col 11:1-28, "...A determination that one of these...")

With respect to claim 29, the rejection of claims 24 is incorporated and further, Luzzi discloses that receiving a message includes: accessing the first value for the first metric by a probe; (Col 18:15-25, "...for accessing data stored in the repository...") generating the message by the probe; (Col 11:28-40, "...to generate an alert signal...") and sending the message to the monitoring apparatus by the probe. (Col 15:5-20, "...to a monitored application program...")

With respect to claim 40, the rejection of claims 39 is incorporated and further, Luzzi discloses if the first value for the first metric is acceptable, software to log the first value

for the first metric. (Col 11:1-28, "...A determination that one of these...")

With respect to claim 42, the rejection of claims 39 is incorporated and further, Luzzi

discloses that the software to determine if the first value for the first metric is acceptable

includes software to compare the first value for the first metric with at least one

acceptable value. (Col 11:15-35, "...The pre-defined performance criteria may

include...")

With respect to claim 44, the rejection of claims 39 is incorporated and further, Luzzi

discloses that the software to receive a message includes:

software to access the first value for the first metric by a probe; (Col 11:20-35, "...have

exceeded such pre-defined performance criteria...")

software to generate the message by the probe; (Col 12:28-40, "...signaling the

violation of pre-defined performance criteria...")

and software to send the message to the monitoring apparatus by the probe. (Col

11:28-40, "...to generate an alert signal...")

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mark P. Francis whose telephone number is (571)272-

7956. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Meng-An Ai can be reached on(571) 272-3756. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

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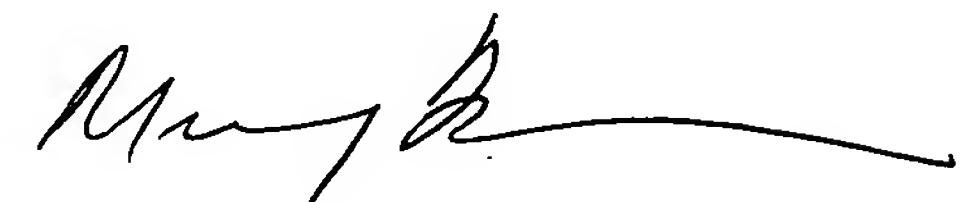
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